

REQUEST FOR RECONSIDERATION  
U.S. Application No. 09/715,171

**I. Prior Art Rejections**

Claim 13 is rejected under 35 U.S.C. § 102(e) as being unpatentable by Karlsson (U.S. Pat. 6,222,829). Claims 1-2, 4-7, 9-13 and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kaaresoja (U.S. Pat. 6,556,573) and further in view of Karlsson (U.S. Pat. 6, 222,829). Claims 3, 8, 14 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kaaresoja (U.S. Pat. 6,556,573) and further in view of Karlsson (U.S. Pat. 6, 222,829) and Olkkonen et al. (U.S. Pat. 6,738,374; hereinafter "Olkkonen"). Applicant respectfully traverses these rejections.

With regard to the § 103 rejections of independent claims 1, 6, 12, 13 and 16, the Examiner concedes that Kaaresoja fails to disclose a transmission channel which has a limited data rate associated with transmission in circuit mode, as claimed. However, the Examiner asserts that Karlsson teaches "second protocol to transmission in circuit mode (col. 2, lines 1-8, col. 3, lines 1-5 and 45-62, col. 4, lines 22-26, incoming 64 kb/s, outgoing 5300 b/s)."

Applicant respectfully submits that claims 1, 6, 12, 13 and 16 would not have been rendered obvious in view of Kaaresoja and Karlsson because the cited references, alone or in combination, do not teach or suggest all of the features of the claims, and one of ordinary skill in the art would not have been motivated to combine and modify the cited references to produce the claimed invention.

The Examiner restates rejections presented in the Office Action dated July 25, 2005 and responds to Applicant's arguments in the January 23, 2006 Amendment by summarizing portions of Kaaresoja and Karlsson. However, the Examiner fails to address, in any manner, how or why

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one skilled in the art would have allegedly been motivated to modify Kaaresoja based on Karlsson.

The Examiner further asserts that:

In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.<sup>1</sup>

However, Applicant respectfully submits that it is proper to argue that there is no motivation to combine the references to overcome a rejection of obviousness.<sup>2</sup> As such, the mere fact references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination. Here, no portion of Kaaresoja, Karlsson, or Olkkonen, provides any teaching or suggestion that would motivate one of ordinary skill in the art to modify and combine the cited references to produce the claimed invention. In particular, Applicant respectfully submits that modifying Kaaresoja's ATM core network (i.e., "to enhance packet data received across the Internet Protocol communication network sent by the mobile station from the Internet Protocol telephony format") is not supported by the teachings of Karlsson since utilizing a transmission channel, which has a limited data rate associated with transmission in circuit mode between the IWF (transcoder 208) and the BTS (200) of Kaaresoja would result in a substantial decrease in the data transmission rate.

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<sup>1</sup> See page 12, paragraph 7 of the Office Action.

<sup>2</sup> See MPEP 2143.01 citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)

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Further, Kaaresoja's ATM core network 206 linking the IWF (transcoder 208) and the BTS (200) is utilized for transmitting data via the ATM protocol in packet mode at a very high data rate transmission. As such, ATM cannot be used for transmission over a transmission channel having a limited data rate associated to transmission in circuit mode. Thus, one of ordinary skill in the art would not have been motivated to modify Kaaresoja's ATM core network.

Accordingly, Applicant respectfully submits claims 1-16 would not have been rendered obvious in view of the Examiner's proposed combination of Kaaresoja and Karlsson because the cited references do not teach or suggest all of the features of the claims and one of ordinary skill in the art would not have been motivated to combine and modify the teachings of the cited references to produce the claimed invention.

With regard to the § 102 rejection of claim 13, the Examiner asserts that Karlsson discloses all of the features of the claimed invention. Claim 13 (as well as claim 16) recites that the data messages formatted in the second protocol are transmitted to or received from another relay over a transmission rate channel having a limited data rate associated to transmission in circuit mode, in order to prevent the claims from allegedly reading on the VMSC (120) of Karlsson. Applicant respectfully submits that the claimed transmission channel having a limited data rate, not matter how broadly construed by the Examiner, cannot correspond to or read on the transmission channel between the VMSC 200 and the mobile station 130 of Karlsson.

Accordingly, Applicant respectfully submits that Karlsson does not teach or suggest "means for transmitting the data messages formatted in the second protocol to another relay over

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a transmission channel having a limited data rate associated to transmission in circuit mode, wherein the data messages formatted in the second protocol include data messages of different lengths.” Thus, Applicant respectfully submits that claim 13 should be allowable over the cited prior art.

**II. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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